

FEB 05 2008

Attorney Docket No.: N1280-00670
App. Serial No.: 10/781,107

REMARKS

This reply is responsive to the final office action mailed December 11, 2007 ("Final Office Action"). A Terminal Disclaimer is filed concurrently herewith as explained below. Claims 1-20 remain pending in the application. Entry of the Terminal Disclaimer and favorable reconsideration with a view towards allowance is respectfully requested in light of the Terminal Disclaimer and remarks which follow.

CLAIMS REJECTIONS

Claims 1-20 stand rejected as being obvious under 35 U.S.C. 103(a) over United States Patent 5,795,688 to Burdorf ("Burdorf") in view of U.S. Patent 7,162,071 to Hung et al ("the '071 Patent"). The '071 Patent, which issued on January 9, 2008 after mailing of the Final Office Action on December 11, 2007, qualifies as prior art to the present application only under 35 U.S.C. 102(e).

"To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." MPEP 2143.02 (citing *In re Royka*, 490 F.2d 981 (CCPA 74)). Furthermore, "[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art." MPEP 2143.02 (citing *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970)).

Both the present application and the '071 patent were co-pending and are commonly owned by Taiwan Semiconductor Manufacturing Company, Ltd., as evidenced by recorded assignments at United States Patent and Trademark Office Reel/Frame Nos. 015009/0129 and 013803/0718, respectively. The present application and the '071 patent further share common inventorship (i.e. "Chang-Cheng Hung" and "Tyng-Hao Hsu"). Accordingly, Applicant files a Terminal Disclaimer concurrently herewith to remove the '071 Patent thereby rendering the standing obviousness rejection moot since Burdorf does not teach or fairly suggest all limitations

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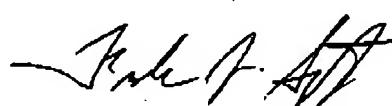
of claims 1-20. Since the '071 patent was not asserted by the Examiner prior to the Final Office Action, Applicant did not have opportunity to take this action earlier during prosecution. Applicant respectfully requests withdrawal of the rejection and allowance of the application.

Notwithstanding the Terminal Disclaimer, Applicant wishes to clarify its position for the record that claims 1-20 remain patentable over Burdorf and respectfully traverses the standing rejection for the same reasons presented in Applicants prior Amendment and Response to Non-Final Office Action filed September 26, 2007, which are repeated and incorporated herein by reference. Burdorf does not teach or fairly suggest acquiring at least one digitized image of at least one "actual feature on a wafer taken directly from a wafer," as required by claims 1-20. Instead, Burdorf merely provides a means for testing only a photomask (not an actual printed wafer feature) by producing a simulated aerial image created by shining a UV exposure light through the mask and then capturing that aerial image on a UV sensitive CCD camera (see Burdorf Col. 3, lines 40-50). Accordingly, Burdorf is incapable of inspecting the fabricated wafer itself for feature printing errors resulting from the actual printing process, which is subject to numerous variable process parameters that may induce printing errors. Applicant respectfully submits that the Final Office Action misinterprets the Burdorf reference.

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In view of the foregoing, Applicants respectfully request favorable reconsideration and allowance of all pending claims. The Examiner is kindly requested to contact the Applicant's undersigned representative at 215.979.1554 to resolve any remaining issues.

Respectfully submitted,

Dated: February 5, 2008By: 

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